

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

AIDEMAR GROUP INC.,

Plaintiff,

v.

HIGHWAYMEN SUPPLY AND
PACKAGING LLC,

Defendant.

Civil Action No.: 2:25-cv-00313

HIGHWAYMEN SUPPLY AND
PACKAGING LLC'S ANSWER,
AFFIRMATIVE DEFENSES, AND
COUNTERCLAIMS TO AIDEMAR
GROUP, INC.'S COMPLAINT

(JURY DEMAND)

**HIGHWAYMEN'S ANSWER, AFFIRMATIVE DEFENSES, AND
COUNTERCLAIMS TO AIDEMAR GROUP INC.'S COMPLAINT**

Defendant-Counterclaimant Highwaymen Supply and Packaging LLC d/b/a Customer Cones USA ("Highwaymen") answers Plaintiff-Counterclaim Defendant Aidemar Group, Inc.'s ("Aidemar") complaint (ECF No. 1), as follows. Any allegations or averments not specifically admitted herein are denied.

NATURE OF THE ACTION

1. Paragraph 1 is a statement of the nature of Aidemar's claims, to which no response is required. To the extent a response is required, Highwaymen admits that Aidemar seeks a

1 declaratory judgment pursuant to 28 U.S.C. § 2201 *et seq.* but denies that Aidemar is entitled to
2 such relief.

3 2. Highwaymen lacks knowledge or information sufficient to form a belief about the
4 truth of the allegations in paragraph 2, and Highwaymen denies the same.

5
6 **THE PARTIES**

7 3. Highwaymen lacks knowledge or information sufficient to form a belief about the
8 truth of the allegations in paragraph 3, and Highwaymen denies the same.

9 4. Highwaymen admits the allegations in paragraph 4.

10 **JURISDICTION AND VENUE**

11 5. Highwaymen admits the allegations in paragraph 5.

12 6. Highwaymen admits the allegations in paragraph 6.

13 7. Highwaymen admits the allegations in paragraph 7.

14 **FACTS AND BACKGROUND**

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16 8. Highwaymen lacks knowledge or information sufficient to form a belief about the
17 truth of the allegations in paragraph 8, and Highwaymen denies the same.

18 9. Highwaymen lacks knowledge or information sufficient to form a belief about the
19 truth of the allegations in paragraph 9, and Highwaymen denies the same.

20 10. Highwaymen lacks knowledge or information sufficient to form a belief about the
21 truth of the allegations in paragraph 10, and Highwaymen denies the same.

22 11. Highwaymen admits that it sells products in the smoking industry but otherwise
23 denies the allegations in paragraph 11.

24 12. Highwaymen lacks knowledge or information sufficient to form a belief about the
25 truth of the allegations in paragraph 12, and Highwaymen denies the same.
26
27

13. Highwaymen admits as to the existence of the published patent applications listed in paragraph 13 and that the documents speak for themselves.

14. Highwaymen lacks knowledge or information sufficient to form a belief about the truth of the allegations in paragraph 14, and Highwaymen denies the same.

15. Highwaymen admits that patents are presumed to be valid under 35 U.S.C. § 282 but otherwise denies the allegations in paragraph 15.

16. Highwaymen admits that it sells products in the smoking industry but otherwise denies the allegations in paragraph 16.

17. Highwaymen lacks knowledge or information sufficient to form a belief about the truth of the allegations in paragraph 17, and Highwaymen denies the same.

18. Highwaymen denies the allegations in paragraph 18.

19. Highwaymen admits the allegations in paragraph 19.

20. Highwaymen admits the allegations in paragraph 20.

21. Highwaymen denies the allegations in paragraph 21.

22. Highwaymen denies the allegations in paragraph 22.

23. Highwaymen admits it received a July 19, 2024 letter but otherwise denies the allegations in paragraph 23.

24. Highwaymen denies the allegations in paragraph 24.

25. Highwaymen denies the allegations in paragraph 25.

26. Highwaymen denies the allegations in paragraph 26.

WILLFUL INFRINGEMENT

27. Highwaymen denies the allegations in paragraph 27.

28. Highwaymen denies the allegations in paragraph 28.

29. Highwaymen denies the allegations in paragraph 29.

CAUSES OF ACTION

COUNT I:

Direct Infringement of U.S. Patent No. 11,395,509 under 35 U.S.C. § 271(a)

30. Highwaymen denies the allegations in paragraph 30.

31. Highwaymen denies the allegations in paragraph 31.

32. Highwaymen denies the allegations in paragraph 32.

33. Highwaymen denies the allegations in paragraph 33.

34. Highwaymen denies the allegations in paragraph 34.

35. Highwaymen denies the allegations in paragraph 35.

36. Highwaymen denies the allegations in paragraph 36.

37. Highwaymen denies the allegations in paragraph 37.

38. Highwaymen denies the allegations in paragraph 38.

39. Highwaymen denies the allegations in paragraph 39.

COUNT II:

Indirect Infringement of U.S. Patent No. 11,395,509 under 35 U.S.C. § 271(b)

40. Highwaymen denies the allegations in paragraph 40.

41. Highwaymen denies the allegations in paragraph 41.

42. Highwaymen denies the allegations in paragraph 42.

43. Highwaymen denies the allegations in paragraph 43.

44. Highwaymen denies the allegations in paragraph 44.

45. Highwaymen denies the allegations in paragraph 45.

46. Highwaymen denies the allegations in paragraph 46.

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AFFIRMATIVE DEFENSES

Further answering the complaint, Highwaymen asserts the following defenses, undertaking the burden of proof on such defenses only to the extent required by law. Highwaymen reserves its right to amend its Answer with additional defenses as more information is obtained. Highwaymen alleges as follows:

48. Highwaymen has not and does not infringe any claim of the '509 Patent either directly or indirectly and either literally or under the doctrine of equivalents.

50. Aidemar cannot prove that this is an exceptional case justifying an award to Aidemar of attorney fees under 35 U.S.C. § 285.

52. Aidemar's complaint fails to state a claim against Highwaymen upon which any of the requested relief may be granted.

1 53. Aidemar's claims for alleged infringement of the '509 Patent is barred, in whole or
2 in part, by the doctrines of express or implied license.

3 54. Aidemar's claims are barred, in whole or in part, by the principles and doctrines of
4 equity, acquiescence, equitable estoppel, unclean hands, laches, and/or waiver.

5 55. Aidemar is not entitled to injunctive relief for any claim because any alleged injury
6 to Highwaymen is not immediate or irreparable, and Aidemar has an adequate remedy at law.

7 56. The claims of the '509 Patent are invalid under the patent laws, including but not
8 limited to 35 U.S.C. § 112, paragraphs 1 and 2, as explained in the Counterclaim below.

9 57. The claims of the '509 Patent are invalid under the patent laws because
10 Highwaymen's Mint Inserts and Patent No. 11,076,632 anticipate and/or would have rendered
11 obvious the '509 Patent under 35 U.S.C. §§ 102 and/or 103, as explained in the Counterclaim
12 below.

13 58. The claims of the '509 Patent are unenforceable under the patent laws because of
14 inequitable conduct during the prosecution of '509 Patent, as explained in the Counterclaim below.

15 59. Highwaymen specifically reserves the right to assert any and all affirmative
16 defenses under Rule 8(c) of the Federal Rules of Civil Procedure, the patent laws of the United
17 States, and any other defense, at law or equity, that may now exist or that may become available
18 through information developed in discovery, at trial, or otherwise.

1 **COUNTERCLAIMS**

2 Under Federal Rule of Civil Procedure 13, Highwaymen brings the following
3 counterclaims against Aidemar:

4 **INTRODUCTION**

5 1. Highwaymen repeats, incorporates, and realleges the foregoing paragraphs as if
6 fully set forth herein.

7 2. This is an action for declaratory judgment of invalidity, non-enforcement, and non-
8 infringement of claims 1-20 of the '509 Patent. This action arises under the Declaratory Judgement
9 Act, 28 U.S.C. §§ 2201 *et seq.* and the patent laws of the United States, Title 35 of the United
10 States Code.

11 3. Highwaymen seeks (1) a declaratory judgement of invalidity of the '509 Patent as
12 a result of the claims' indefiniteness and lack of written description under 35 U.S.C. §112 and
13 anticipating prior art under 35 U.S.C. §102 and/or obviousness under 35 U.S.C. § 103; (2) a
14 declaratory judgement that the '509 Patent is unenforceable as a result of Mr. Wahidi and/or
15 Aidemar's inequitable conduct before the U.S. Patent and Trademark Office ("Patent Office")
16 during prosecution of the '509 Patent, and (3) a declaratory judgement of non-infringement of the
17 '509 Patent.

18 4. By its complaint, Aidemar alleges that the '509 Patent is valid and enforceable and
19 that Highwaymen has infringed the '509 Patent. Highwaymen denied those allegations.

20 5. Highwaymen contends that it does not infringe the '509 Patent, that the '509 Patent
21 is invalid, and that the '509 Patent is unenforceable. An immediate, real, and justiciable
22 controversy therefore exists between Aidemar and Highwaymen with respect to the validity,
23 enforceability, and infringement of the '509 Patent.

6. There is an actual case or controversy between Highwaymen and Aidemar regarding the validity, enforceability, and infringement of the '509 Patent, including by reason of Aidemar having filed a complaint accusing Highwaymen of infringing one or more claims of the '509 Patent.

THE PARTIES

7. Highwaymen is a limited liability company formed under the laws of Washington and does business in Renton, Washington.

8. On information and belief, Aidemar is a corporation that is incorporated in California and has its principal place of business in Vernon, California.

JURISDICTION AND VENUE

9. This Court has subject-matter jurisdiction over Highwaymen’s counterclaims under 28 U.S.C. §§ 1331, 1338(a), and 2201(a) because they arise under the Patent Act and the Declaratory Judgement Act.

10. This Court has supplemental jurisdiction under 28 U.S.C. § 1367(a) because the counterclaims are so related to Aidemar’s claims that they form part of the same case or controversy under Article III of the United States Constitution.

11. This Court has personal jurisdiction over Aidemar because Aidemar has consented to the Court's jurisdiction by virtue of filing suit against Highwaymen in this Court.

12. Venue is proper in this district under 28 U.S.C. §§ 1391(b) and 1400(b).

FIRST COUNTERCLAIM

(Declaratory Judgment of Invalidity of the '509 Patent under 35 U.S.C. § 112)

13. Highwaymen repeats, incorporates, and realleges the foregoing paragraphs as if fully set forth herein.

1 14. Each of the asserted claims of the '509 Patent is invalid for failing to comply with
2 one or more of the conditions of patentability set forth in Title 35 of the United States Code,
3 including Sections 101, 102, 103, and/or 112.

4 15. For example, claims 1-20 of the '509 Patent violate 35 U.S.C § 112 because they
5 are ambiguous, indefinite and violate the written description requirement.
6

7 16. Claim 1 of the '509 Patent recites:
8 “An insert for use as a mouthpiece to a smokable item and for securing at least one
9 flavor releasing mechanism, the insert comprising . . . a first aperture in the front of the
10 section and extending to the back of the section, the first aperture located between the top
11 side and the bottom side and extending to a point closer to the first side than it extends to
the second side; *wherein the section is adapted to be folded in an area of the first aperture
thereby forming a first cavity in the area of the first aperture.*”

12 (ECF No. 1-1 at 7:30-56 (emphasis added).)

13 17. Claim 11 of the '509 Patent similarly recites:
14 A method of creating an insert for use as a mouthpiece to a smokable item and for
15 securing at least one flavor releasing mechanism, the method comprising: . . . *folding the*
16 *section in an area of the first aperture thereby forming a first cavity in the area of the first*
aperture, wherein the first cavity is adapted to receive and secure at least one flavor
releasing mechanism.

17 (ECF No. 1-1 at 8:18-32 (emphasis added).)
18

19 18. The italicized language in claims 1 and 11 in paragraphs 16 and 17 recite purely
20 functional language and do not adequately describe structure that performs the recited function.
21 For example, the italicized claim language does not recite any structural limitation for a “first
22 cavity,” nor does the claim recite how the section is to be folded in the area of the aperture to form
23 such “first cavity,” rendering the claim vague and indefinite. Nor does the italicized language
24 positively recite how such “first cavity” is “adapted” to receive a flavor releasing mechanism.
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26 19. Additionally, claims 1 and 11 encompass many more embodiments and
27 possibilities than are explicitly disclosed in the specification of the '509 Patent as there are

indefinite ways to fold a “section” in the “area of the first aperture” to “form[] a . . . cavity.” As such, the inventor of the ’509 Patent did not possess the full scope of the claimed invention at the time of filing.

20. The broad and vague language of claims 1 and 11 therefore violate Section 112's written description and definiteness requirements.

21. Because claims 2-10 depend on claim 1 and claims 12-20 depend on claim 11, claims 1-20 of the '509 Patent are invalid. Accordingly, Highwaymen is entitled to a judicial declaration that claims 1-20 of the '509 Patent are invalid under Section 112.

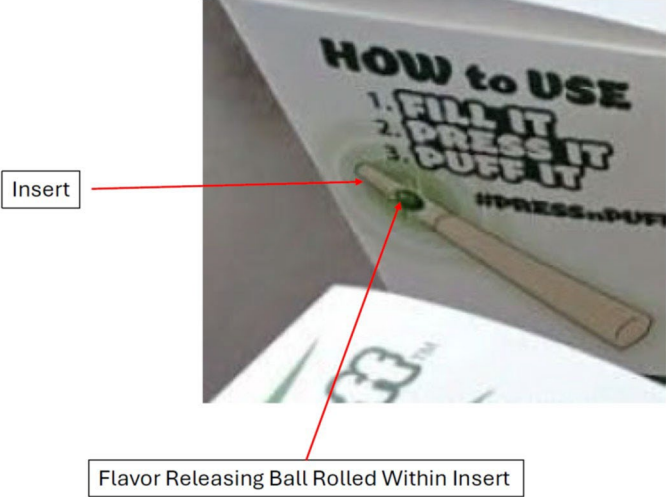
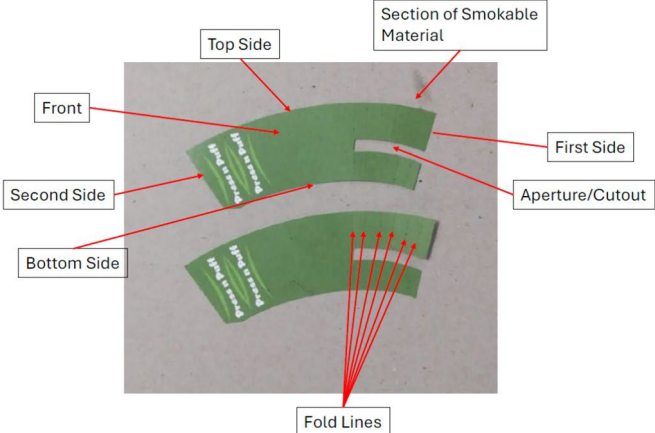
SECOND COUNTERCLAIM

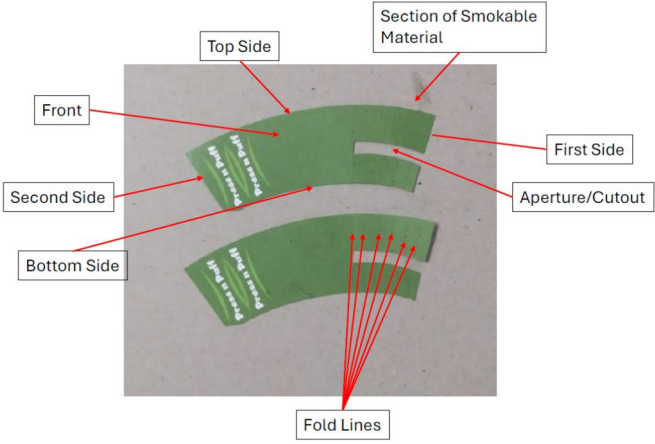
(Declaratory Judgment of Invalidity of the '509 Patent Because Highwaymen's Mint Inserts, the '632 Patent and/or the Provisional Application of the '632 Patent Anticipate and/or Render Obvious the '509 Patent)

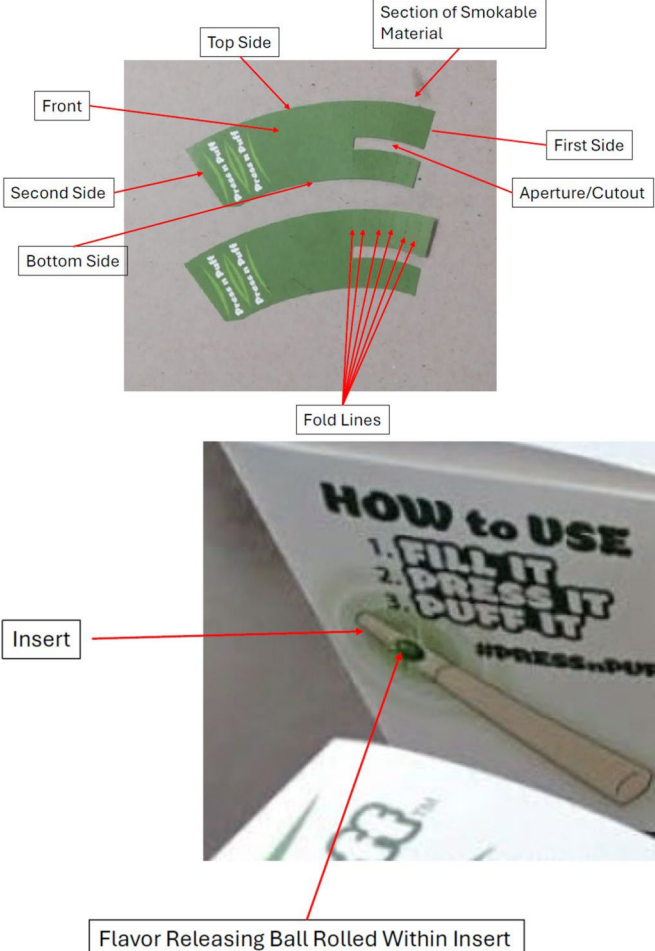
22. Highwaymen repeats, incorporates, and realleges the foregoing paragraphs as if fully set forth herein.

23. Highwaymen began offering for sale a smokeable device called Mint Inserts in March 2020 and began selling the Mint Inserts in June 2020—about *twelve* and *eight months* before the '509 Patent's earliest possible priority date, which is, on information and belief, March 19, 2021.

24. The Mint Inserts teach each and every claimed element of asserted claim 1 of the '509 Patent as shown by the following claim chart:

The '509 Patent	Highwaymen's Prior Art: June 2020 Mint Inserts
<p>Claim 1. An insert for use as a mouthpiece to a smokable item and for securing at least one flavor releasing mechanism, the insert comprising:</p>	<p><i>Highwaymen's June 2020 Mint Inserts were smokable and secured a flavor releasing mechanism (flavor ball):</i></p> 
<p>a section of smokable material including a first side, a second side opposite the first side, a top side, a bottom side, a front, and a back; and</p>	<p><i>Highwaymen's June 2020 Mint Inserts included a section of smokable material including a first side, a second side opposing the first side, a top side, a bottom side, a front and a back (the back side opposing the front side).</i></p> 

The '509 Patent	Highwaymen's Prior Art: June 2020 Mint Inserts
<p>a first aperture in the front of the section and extending to the back of the section, the first aperture located between the top side and the bottom side and extending to a point closer to the first side than it extends to the second side;</p>	<p><i><u>Claim Construction Note:</u> The attorney who drafted the '509 Patent, Michael N. Cohen of Cohen IP Law Group PC (see ECF No. 1-1 at 2, citing "Attorney, Agent, or Firm"), was careful to note that the words "aperture" and "cutout" are to be used interchangeably. (See Id. at 3:34 ("[] the section includes a cutout (also referred to as an aperture []"). Said differently: the '509 Patent uses the terms "aperture" and "cutout" synonymously. As such, there can be no serious question that a "cutout" as used in the June 2020 Mint Inserts meets the claimed limitation of an "aperture."</i></p> <p><i>Highwaymen's June 2020 Mint Inserts included a first aperture/cutout in the front of the section that extended through to the back of the section. The aperture/cutout was located between the top side and the bottom side. And the aperture/cutout extended to a point closer to the first side as compared to its extent toward the second side.</i></p>  <p>The diagram shows a green, curved section of smokable material. It has a central cutout. Labels with red arrows point to various parts: 'Top Side' at the top edge, 'Bottom Side' at the bottom edge, 'Front' on the left side, 'Second Side' on the right side, 'First Side' at the top right corner, 'Aperture/Cutout' pointing to the central opening, and 'Fold Lines' at the bottom edge. A label 'Section of Smokable Material' points to the top right corner.</p>

The '509 Patent	Highwaymen's Prior Art: June 2020 Mint Inserts
<p>wherein the section is adapted to be folded in an area of the first aperture thereby forming a first cavity in the area of the first aperture, and wherein the first cavity is adapted to receive and secure at least one flavor releasing mechanism.</p>	<p><i>Highwaymen's June 2020 Mint Inserts' section was adapted to be folded in an area (along displayed fold lines) of the first aperture/cutout to form a first cavity in that area, where the cavity was adapted to receive and secure a flavor releasing mechanism (flavor ball).</i></p>  <p>The diagram illustrates the components and assembly of the mint insert. The top portion shows a green, C-shaped 'Section of Smokable Material' with 'Fold Lines' indicated by red arrows. The material has a 'Front' side, a 'Second Side', and a 'Bottom Side'. An 'Aperture/Cutout' is located on the 'First Side'. Below this, a close-up shows the 'Insert' being placed into the 'Aperture/Cutout', with a 'Flavor Releasing Ball Rolled Within Insert'.</p>

25. Similar invalidating charts may be made for the remaining claims 2-20 of the '509 Patent.

1 26. The America Invents Act, pursuant to 35 U.S.C. § 102(a), renders a patent invalid
2 if “the claimed invention was [] *on sale, or otherwise available to the public* before the effective
3 filing date of the claimed invention” (Emphasis added).

4 27. Highwaymen’s Mint Inserts were publicly available and publicly on-sale and sold
5 in the United States before the earliest possible priority date of the claimed invention and therefore
6 render the ’509 Patent invalid.

7 28. This information was communicated to Aidemar during a March 3, 2025 video call
8 with Aidemar’s counsel, during which Highwaymen’s counsel explained that Highwaymen began
9 selling the Mint Inserts beginning June 2020. (*See* Exhibit A at 2.) Highwaymen’s counsel also
10 explained how the Mint Inserts anticipated the ’509 Patent. (*Id.*).

11 29. Having not heard from Aidemar’s counsel, Highwaymen’s counsel sent a letter to
12 Aidemar on May 2, 2025, which further put Aidemar on notice that its infringement theories are
13 baseless. (Exhibit A.) In the letter, Highwaymen re-explained in detail that Highwaymen did not,
14 and could not, infringe claims 1-20 of the ’509 Patent because the Mint Inserts anticipated the
15 ’509 Patent. (*Id.*) Highwaymen requested that Aidemar voluntarily withdraw the lawsuit on or
16 before May 23, 2025 before Highwaymen was required to engage in motion practice to dismiss
17 the case. (*Id.*) Highwaymen also cautioned that Aidemar had a continuing duty to assess the
18 soundness of pending infringement claims. (*Id.*)

19 30. Along with the letter, Highwaymen sent a sworn declaration from Harrison Bard,
20 Highwaymen’s Chief Executive Officer, stating under oath that Highwaymen started offering for
21 sale the Mint Inserts on March 13, 2020 and selling the same as early as June 24, 2020. (Exhibit
22 A at 7.)

1 31. Aidemar’s counsel responded over a month later, on June 5, 2025, after multiple
2 follow-up communications from Highwaymen requesting a response and requesting that Aidemar
3 voluntarily withdraw the complaint.

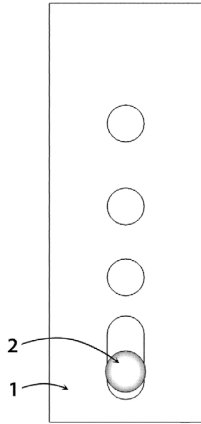
4 32. In its June 5, 2025 letter, Aidemar’s counsel, Michael N. Cohen (the same attorney
5 who prosecuted the ’509 Patent in the USPTO) blanketly stated that “it is clear to us that the image
6 you provided is entirely distinguishable from the ‘509 Patent and does not in any way read upon
7 any of its claims” because “[y]our interpretation of ‘aperture’ is not consistent with the
8 prosecution, claims, drawings or specification of the ‘509 Patent.” (Exhibit B.) But this is not
9 correct, because the specification of the ‘509 Patent, presumably drafted by Mr. Cohen, expressly
10 supports Highwaymen’s construction: The specification of the ’509 Patent broadly defines the
11 term aperture and does not limit the term to any specific shape or embodiment. For example, the
12 specification of the ’509 Patent uses the terms “aperture” and “cutout” interchangeably. (See ECF
13 No. 1-1 at 3:34 (“[T]he section includes a cutout (also referred to as an aperture. . . .”).
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16 33. In the same letter, Aidemar’s counsel further identified Patent No. 11,076,632
17 (“’632 Patent”) as “cover[ing] the design of . . . Highwaymen’s Mint Inserts.” (Exhibit B.)
18

19 34. The ’632 Patent was filed on September 25, 2020—more than five months before
20 the earliest possible priority date of the ’509 Patent—and claims priority to Provisional Application
21 Ser. No. 62/925,604 (“Provisional Application of the ’632 Patent”), filed on Oct. 24, 2019—more
22 than a year before the earliest possible priority date of the ’509 Patent. The ’632 Patent was
23 published on August 3, 2021—two months before the ’509 Patent was filed. (Exhibit C.) Thus, the
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'632 Patent is prior art to the '509 Patent at least under 35 U.S.C. § 102(a)(2). If Highwaymen's Mint Inserts anticipate the '509 Patent, so does the '632 Patent.¹

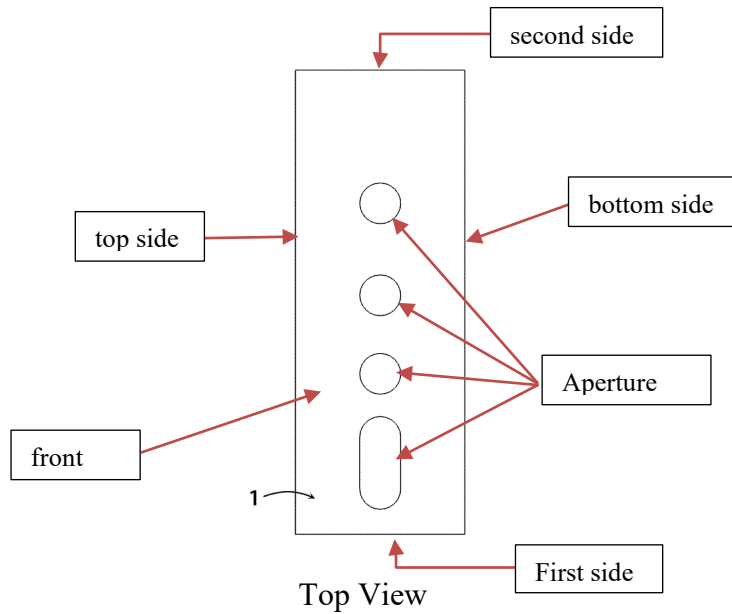
35. Further, the disclosures in the Provisional Application of the '632 Patent teach each and every element of asserted claim 1 of the '509 Patent as shown in the following claim chart:

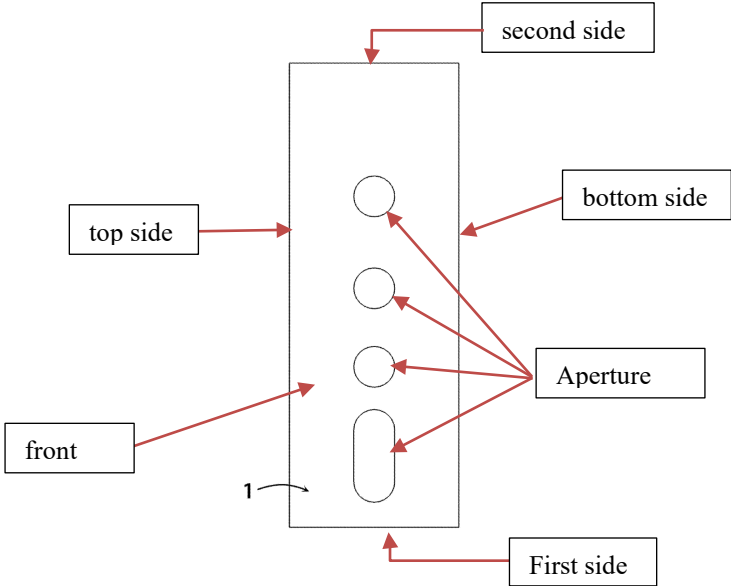
The '509 Patent	Provisional Application of the '632 Patent
Claim 1. An insert for use as a mouthpiece to a smokable item and for securing at least one flavor releasing mechanism, the insert comprising:	<p><i>The Provisional Application of the '632 Patent provides a (1) "tip" that is smokeable and secures a flavor releasing mechanism ((2) "flavor capsule"). "The user would use one of these tips while rolling a smoke." The provisional application includes "at least one flavor releasing mechanism" as it provides that "more than one flavor capsule could be added." (Exhibit C.)</i></p>  <p>Top View</p>

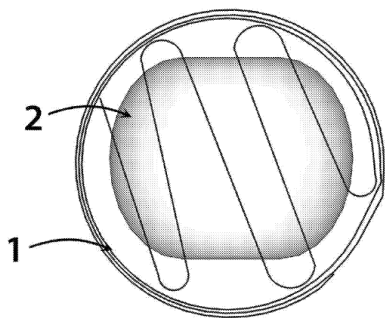
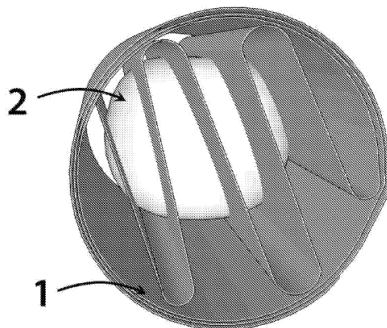
¹ Highwaymen assumes for purposes of this counterclaim that Aidemar's counsel's representation that the '632 Patent "covers the design of . . . Highwaymen's Mint Inserts" is true. However, Highwaymen reserves the right to amend its position.

a section of smokable material including a first side, a second side opposite the first side, a top side, a bottom side, a front, and a back; and

The provision application includes a section of smokable “paper or cardboard” material (1) including a first side, a second side opposing the first side, a top side, a bottom side, a front and a back (the back side opposing the front side). (Exhibit C.)



The '509 Patent	Provisional Application of the '632 Patent
<p>a first aperture in the front of the section and extending to the back of the section, the first aperture located between the top side and the bottom side and extending to a point closer to the first side than it extends to the second side;</p>	<p><i>Claim Construction Note: The attorney who drafted the '509 Patent, Michael N. Cohen of Cohen IP Law Group PC (see ECF No. 1-1 at 2, citing "Attorney, Agent, or Firm"), was careful to note that the words "aperture" and "cutout" are to be used interchangeably. (See Id. at 3:34 ("[] the section includes a cutout (also referred to as an aperture []"). Said differently: the '509 Patent uses the terms "aperture" and "cutout" synonymously. As such, there can be no serious question that the terms "holes . . . cut into the paper" and a "pre-cut hole" as used in the Provisional Application of the '632 Patent meet the claimed limitation of an "aperture."</i></p> <p><i>The Provisional Application of the '632 Patent included a first aperture/cutout in the front of the section that extended through to the back of the section. "A single or series of holes (circular and/or elongated) are cut into the paper or cardboard material that can be used to create the tips." The aperture/cutout was located between the top side and the bottom side. And, as shown in the Figure below, the elongated aperture/cutout extended to a point closer to the first side as compared to its extent toward the second side. (Exhibit C.)</i></p>  <p>The diagram, labeled 'Top View', shows a vertical rectangle. On the left side, a label 'front' has an arrow pointing to the rectangle. On the right side, there are three labels: 'second side' at the top, 'bottom side' in the middle, and 'First side' at the bottom. Inside the rectangle, there are four apertures: three small circles and one larger elongated oval at the bottom. A label 'Aperture' has four arrows pointing to each of these shapes. A label '1' with a curved arrow points to the elongated oval. The elongated oval is positioned closer to the 'First side' than to the 'second side'.</p>

The '509 Patent	Provisional Application of the '632 Patent
<p>wherein the section is adapted to be folded in an area of the first aperture thereby forming a first cavity in the area of the first aperture, and wherein the first cavity is adapted to receive and secure at least one flavor releasing mechanism.</p>	<p><i>The (1) tip in the Provisional Application of the '632 Patent was adapted to be folded in an area of the first aperture/cutout to form a first cavity in that area, where the cavity was adapted to receive and secure (2) a flavor releasing mechanism (flavor capsule). As shown in the figures below, the tip material (1) with the apertures is folded accordion-style to create a cavity in which the flavor capsule (2) is received. (Exhibit C.)</i></p> <div data-bbox="803 709 1185 1024">  </div> <p style="text-align: center;">Front View</p> <div data-bbox="782 1176 1166 1501">  </div> <p style="text-align: center;">Perspective View</p>

36. The disclosures in the Provisional Application of the '632 Patent qualify as prior art under 35 U.S.C. § 102(a)(2), at least because “the claimed invention was described in . . . an application for patent published or deemed published under section 122(b), in which the patent or

1 application, as the case may be, names another inventor and was effectively filed before the
2 effective filing date of the claimed invention.”

3
4 37. Section 103 of Title 35 also renders a patent invalid as obvious based on two or
5 more disclosures that qualify as prior art under Section 102. *Sparton Corp. v. United States*,
6 89 Fed. Cl. 196, 210 (2009).

7 38. Highwaymen seeks a declaration from this Court that all claims 1-20 the
8 '509 Patent are invalid as being anticipated under 35 U.S.C. § 102 at least by Highwaymen's Mint
9 Inserts, the '632 Patent and/or the Provisional Application of the '632 Patent, or as being obvious
10 under 35 U.S.C. § 103 based at least on a combination of Highwaymen's Mint Inserts, the
11 '632 Patent and/or the Provisional Application of the '632 Patent.
12

13 39. Upon information and relief, Aidemar performed no prefiling analysis of the
14 soundness of its infringement claims. Given that Aidemar has not dismissed its lawsuit in light of
15 Highwaymen's letter and sworn declaration regarding Highwaymen's prior art Mint Inserts and
16 Aidemar's knowledge of the '632 Patent (and presumed knowledge of the Provisional Application
17 of the '632 Patent), Aidemar has also performed no post-filing analysis of the soundness of its
18 infringement claims.
19

20 40. This case, therefore, is an exceptional case under 35 U.S.C. § 285, and
21 Highwaymen is entitled to recover attorneys' fees and costs.

22 **THIRD COUNTERCLAIM**

23 (Declaratory Judgment of Unenforceability of the '509 Patent Due to Inequitable Conduct
24 During Prosecution of the '509 Patent)

25 41. Highwaymen repeats, incorporates, and realleges the foregoing paragraphs as if
26 fully set forth herein.
27

1 42. The '509 Patent is unenforceable as a result of Aidemar's inequitable conduct
2 before the Patent Office.

3 43. As stated above, Highwaymen began offering for sale the Mint Inserts in March
4 2020 and began selling the same in June 2020—about twelve and eight months before the
5 '509 Patent's earliest possible priority date. As further explained above, the Mint Inserts and the
6 '632 Patent are material to the patentability of the '509 Patent because they disclose each and every
7 claimed element of the '509 Patent.
8

9 44. Because the smoking industry is small, members in the industry know which
10 products are in the marketplace, including Highwaymen's Mint Inserts and the '632 Patent.

11 45. On information and belief, Jawid Wahidi, the inventor of the '509 Patent, and/or
12 Aidemar, the assignee of the '509 Patent, knew of the existence of the Mint Inserts and the
13 '632 Patent, or similar products, being available for purchase before filing the '509 Patent and
14 while the '509 Patent was being prosecuted by Mr. Michael N. Cohen.
15

16 46. Mr. Wahidi, Aidemar, and prosecution counsel (Mr. Cohen) were also made aware
17 of the existence of the Mint Inserts as prior art, when counsel for Highwaymen sent a letter to
18 Aidemar's counsel (Mr. Cohen) on May 2, 2025, after a March 3, 2025 video call informing
19 Aidemar of the existence of the March 2020 offers for sale and June 2020 sales of the Mint Inserts.
20 (Exhibit A.)
21

22 47. Mr. Wahidi and/or Aidemar were again reminded of the March 2020 offers for sale
23 and June 2020 sales of the Mint Inserts in the May 2, 2025 letter from Highwaymen's counsel.
24 (Exhibit A.)
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27

1 48. Aidemar’s counsel, in response, admitted to Highwaymen that the Mint Inserts
2 were not disclosed during the prosecution of the ’509 Patent, but argued that the ’632 Patent was
3 cited in a *continuation* of the ’509 Patent *that is not asserted in this suit*. (Exhibit B.)
4

5 49. Aidemar took no steps to disclose the Mint Inserts to the Patent Office during and
6 since the prosecution of the ’509 Patent and rather maintained this baseless lawsuit against
7 Highwaymen.

8 50. In addition to failing to disclose Highwaymen’s Mint Inserts as prior art during the
9 prosecution of the ’509 Patent, Mr. Wahidi, Aidemar and prosecution counsel (Mr. Cohen) also
10 failed to disclose the ’632 Patent despite knowing it’s materiality to the claims of the ’509 Patent.
11 In fact, Mr. Wahidi, Aidemar and prosecution counsel (Mr. Cohen) failed to disclose *any* prior art
12 to the Patent Office during the prosecution of the ’509 Patent.
13

14 51. As stated earlier, the ’632 Patent was published on August 3, 2021—two months
15 before the ’509 Patent was filed. In the June 5, 2025 letter to Highwaymen, Aidemar’s counsel
16 took the position that the ’632 Patent “covers the design of . . . Highwaymen’s Mint Inserts.”
17 (Exhibit B.) If Highwaymen’s Mint Inserts anticipate or would have rendered obvious the
18 ’509 Patent, so does the ’632 Patent.² And as stated in paragraph 35, the Provisional Application
19 of the ’632 Patent disclosed the invention claimed in the ’509 Patent.
20

21 52. On March 28, 2022, about three months before the ’509 Patent issued, Mr. Wahidi,
22 Aidemar, and prosecution counsel (Mr. Cohen) became aware of the ’632 Patent and its materiality
23 with respect to the ’509 Patent because the ’632 Patent was cited in a rejection of a related Aidemar
24 patent application (also invented by Mr. Wahidi), U.S. Ser. No. 17/583,039, entitled “Spiral Insert
25

26 ² Here again, Highwaymen assumes for purposes of this counterclaim that Aidemar’s counsel’s representation that the
27 ’632 Patent “covers the design of . . . Highwaymen’s Mint Inserts” is true. However, Highwaymen reserves the right
to amend its position.

1 with Flavor Releasing Mechanisms.” The Examiner in that rejection, referring to the
2 ’632 Patent as “Ormaza”) stated as follows:

3 With reference to Figs. 1 and 5-7, Ormaza discloses a conical or cylindrical joint
4 or blunt tip for placement at the end of a joint where a smoker places their mouth (for
5 use as a mouthpiece), and housing at least one crushable flavor capsule (flavor
6 releasing mechanism) to enhance the smoking experience for a user (Abs; col 1, lines
7 15-19; col 2, lines 3-16; col 3, lines 14-17; col 5, lines 3-5 and 13-18; Claim 1), the tip
8 including a pre-rolled section forming an elongate member 10 (col 2, lines 32-36 and
9 54-56) having open ends defining an inner volume extending therebetween (as depicted
10 in Figs. 1 and 7) or, at least a first open end and a second open end opposite the first
11 open end would have been obvious to one of ordinary skill in the art from the disclosure
12 and to allow use of the tip as a mouthpiece. The tip is formed from a tip sheet 22 and
13 further comprises a corrugated section 24 as a portion of the pre-rolled section folded
14 along crease lines 26 and disposed to traverse the inner volume from the first open end
15 to the second open end, the corrugated section serving as a partition to separate the
16 inner volume into at least two elongate compartments (Figs 1, 6 and 7; col 3, lines 32-
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1 33 and 41-45; col 4, lines 4-15 and 43-47). The corrugated section (partition) comprises
2 a cut-out portion 27 (col 3, lines 52-53), the crushable flavor capsule 40, 42 (flavor
3 releasing system) within the cut-out portion (col 3, line 66 to col 4, line 3; col 4, lines 13-
4 20 and 43-60) and held within the inner volume by the partition (Abs; col 5, lines 8-10
5 and 18-19). The tip of Omaza reads on the claimed insert system for use as a
6 mouthpiece to a smokable item and for securing at least one flavor-releasing
7 mechanism.
8

9 (Exhibit D.)
10

11 53. Yet, despite knowing about the '632 Patent and its materiality with respect to the
12 claimed subject matter in the '509 Patent about three months before the '509 Patent issued, Mr.
13 Wahidi, Aidemar and/or Mr. Cohen did not disclose the '632 Patent during the prosecution of the
14 '509 Patent.

15 54. Mr. Wahidi, as the inventor of the '509 Patent, Aidemar, as a party involved in the
16 prosecution of the '509 Patent, and Mr. Cohen, as prosecution counsel, had a duty to disclose to
17 the Patent Office any information known to them to be material to the patentability of the
18 '509 Patent. 37 C.F.R. § 1.56.
19

20 55. On information and belief, Mr. Wahidi, Aidemar and/or Mr. Cohen intentionally
21 withheld knowledge of these two prior art references to the Patent Office during prosecution of
22 the '509 Patent. In fact, Mr. Wahidi, Aidemar, and Mr. Cohen did not file *any* Information
23 Disclosure Statemen during prosecution of the '509 Patent.

24 56. Therefore, Mr. Wahidi, Aidemar and/or Mr. Cohen violated their duty of
25 disclosure, candor, and good faith during the prosecution of the '509 Patent. Accordingly, the
26
27

1 '509 Patent is unenforceable due to Mr. Wahidi's, Aidemar's and/or Mr. Cohen's inequitable
2 conduct during the prosecution of the '509 Patent.

3 57. Highwaymen seeks a declaration from this Court that the '509 Patent is
4 unenforceable because of Mr. Wahidi's, Aidemar's and/or Mr. Cohen's inequitable conduct during
5 the prosecution of the '509 Patent.

6
7 58. Aidemar filed its complaint in this action against Highwaymen knowing that the
8 '509 Patent is unenforceable and that Highwaymen has not infringed and does not infringe any
9 claim of the '509 Patent.

10 59. This case, therefore, is an exceptional case under 35 U.S.C. § 285, and
11 Highwaymen is entitled to recover attorneys' fees and costs.

12 **FIFTH COUNTERCLAIM**

13 (Declaratory Judgment of Non-Infringement of the '509 Patent)

14 60. Highwaymen repeats, incorporates, and realleges the foregoing paragraphs as if
15 fully set forth herein.

16
17 61. Highwaymen does not directly infringe, indirectly infringe, induce the
18 infringement, or contribute to the infringement (either literally or under the doctrine of
19 equivalents), including willfully, of any valid and/or enforceable asserted claim of the '509 Patent.

20 62. Highwaymen does not infringe any valid and/or enforceable claim of the
21 '509 Patent in any manner under any section of 35 U.S.C. § 271, either alone or jointly with any
22 other individual or entity.

23 63. Highwaymen seeks a declaration from this Court that Aidemar has not and is not
24 now infringing, actively inducing the infringement of, or contributorily infringing any valid claim
25 of the '509 Patent.
26

64. Aidemar filed its complaint in this action against Highwaymen knowing that the '509 Patent is invalid and unenforceable and that Highwaymen has not infringed and does not infringe any valid claim of the '509 Patent.

65. This case, therefore, is an exceptional case under 35 U.S.C. § 285, and Highwaymen is entitled to recover attorneys' fees and costs.

PRAYER FOR RELIEF

WHEREFORE, Highwaymen prays for the following relief:

1. Dismissal with prejudice of Aidemar's complaint against Highwaymen;
2. Judgment that Aidemar is not entitled to any relief whatsoever, whether in law or equity or otherwise, from its suit against Highwaymen;
3. Judgment that Highwaymen does not infringe, and has not infringed, the '509 Patent under any theory of infringement;
4. Judgment that the '509 Patent is invalid;
5. Judgment that the '509 Patent is unenforceable;
6. An entry of judgment in Highwaymen's favor and against Aidemar on all of the Counterclaims;
7. An order declaring this an exceptional case and awarding Highwaymen its attorneys' fees and costs in accordance with 35 U.S.C. § 285; and
8. Such other relief as the Court may deem just and proper.

JURY DEMAND

Under Rule 38 of the Federal Rules of Civil Procedure, Highwaymen demands a trial by jury on all issues so triable.

1 Defendant is not aware of the existence of any applicable insurance agreement of the kind
2 described in Rule 26(a)(1)(A)(iv)).

3
4 Dated: June 20, 2025.

Respectfully submitted,

5 /s Paul J. Bruene

6 Douglas A. Grady, 36100

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